

### **REMARKS**

Applicant thanks the Examiner for the very thorough consideration given the present application. Claims 1-14 are now present in this application. Claims 1 and 7 are independent. Reconsideration of this application is respectfully requested.

#### **Priority Under 35 U.S.C. § 119**

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

#### **Title of the Invention**

The Examiner objected to the Title of the Invention as not being descriptive. Responsive thereto, the Title has been changed to "ONLINE IMAGE PRINT SERVICE SYSTEM." Accordingly, applicant respectfully requests reconsideration and withdrawal of the requirement and entry of the new Title.

#### **Rejections under 35 U.S.C. §103**

Claims 1, 2, 4, 7-9, 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Clough in view of Ishijima. Applicant submits the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverses the rejection. A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach or suggest each and every element in the claims. See *M.P.E.P.* § 706.02(j); *M.P.E.P.* 2141-2144.

"Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (See *In Re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C.

§103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

Applicant respectfully submits that this rejection is improper for a number of reasons. First, the base reference to Clough is directed to a method for downloading image data files from a camera, which does not have, among other things, a first recording device, a first communications device, a predetermined home server apparatus that includes a second communications device that receives the image data, a third communications device that automatically transmits the image data and user information to a print server apparatus, the print server apparatus includes a fourth communications device that receives the image data and the user information from the home server, and a first output device that outputs the image data when the user issues an order as specifically recited in claims 1 and 7.

The Examiner admits that Clough does not have a user data management device as recited. Instead, the base reference to Clough has a wireless digital media card for wirelessly transferring image data to devices on a network under the control of logic 122. Logic 122 causes the image data to be stored in memory 124 in media card 114. Image data can then be transferred into memory 136 by logic 134. Thus, the base reference to Clough is concerned with serially dumping image data so that a photo session can continue without interruption, significantly different than what is claimed. Clough does not disclose or suggest the claimed invention.

Clough does not have the features required by independent claim 1, including but not limited to, a fourth communications device which receives image data and the predetermined user information from the home server apparatus, a third recording device which records the

image data received by said fourth communications device for each user specified by the predetermined user information; a user data management device which manages image data of a user recorded by said third recording device, and a first output device which outputs the image data recorded by said third recording device to a medium when the user issues an order, and wherein said user data management device updates at least one of a total number of pieces of image data and a total amount of image data about a user specified by the predetermined user information each time said fourth communications device receives image data and the predetermined user information from the home server apparatus, and automatically transmits message information to equipment registered in advance for the user when the updated result exceeds a predetermined value, wherein the message information includes a proposal for the user to output image data to a medium. It is respectfully submitted that none of these features are present in Clough.

Similarly, Clough does not have the features required by independent claim 7, including but not limited to, a third communications device which automatically transmits the image data recorded by said second recording device and predetermined user information to a predetermined print server apparatus, and an image data management device which manages image data recorded in said second recording device, and wherein said image data management device updates at least one of a total number of pieces of image data and a total amount of image data each time said third communications device transmits image data to the specified print server apparatus, and automatically transmits message information to equipment registered in advance when the updated result exceeds a predetermined value; and wherein said message information includes a proposal to output image data to a medium from said print server apparatus.

Second, the secondary reference to Ishijima appears to disclose providing discount service by printing advertisements in the margins of paper being copied by a photocopier service. The sections referenced by the Examiner, column 6, lines 47-59 and column 5, lines 12-17, relate to "the advertiser pays advertisement fee in advance, and when the user prints page with advertisement, it is determined if the accumulated cost exceeds the paid fee", and thus it is different from "determining updated result of total number/amount of images exceed the predetermined value or not" in claim 1 of the present application. Moreover, the feature "when

the accumulated cost exceeds the paid fee, printing advertisement to the user's print is suspended" in Ishijima does not relate to "transmitting a message including a proposal for the user to output image data to a medium" in the present application at all. The secondary reference to Ishijima neither discloses nor suggests a fourth communications device which receives image data and the predetermined user information from the home server apparatus, a third recording device which records the image data received by said fourth communications device for each user specified by the predetermined user information; a user data management device which manages image data of a user recorded by said third recording device, and a first output device which outputs the image data recorded by said third recording device to a medium when the user issues an order, wherein said user data management device updates at least one of a total number of pieces of image data and a total amount of image data about a user specified by the predetermined user information each time said fourth communications device receives image data and the predetermined user information from the home server apparatus, and automatically transmits message information to equipment registered in advance for the user when the updated result exceeds a predetermined value, wherein the message information includes a proposal for the user to output image data to a medium, as recited in claim 1, and from which claims 2 and 4 depend. Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 1, 2, and 4.

Moreover, the Office Action has provided no reasonable basis for the alleged combination of Clough and Ishijima. Clough and Ishijima are in different technical fields and are attempting to solve different problems. Why would one working in the art of automatic image data downloads so that a photographer does not have to stop shooting to transfer image space to free up camera memory, as in Clough, turn to the art of inserting advertisements in a photocopy machine, as in Ishijima? To date, no basis has been established on the record for connecting these two disparate arts, much less a clearly articulated motivation statement based upon the facts present in the references.

Similarly, Ishijima neither discloses nor suggests a third communications device which automatically transmits the image data recorded by said second recording device and predetermined user information to a predetermined print server apparatus, and an image data

management device which manages image data recorded in said second recording device, and wherein said image data management device updates at least one of a total number of pieces of image data and a total amount of image data each time said third communications device transmits image data to the specified print server apparatus, and automatically transmits message information to equipment registered in advance when the updated result exceeds a predetermined value; and wherein said message information includes a proposal to output image data to a medium from said print server apparatus, as recited in claim 7, and from which claims 8, 9, 11 and 12 depend. Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 7, 8, 9, 11 and 12.

Nowhere in either Clough or Ishijima is there a process for notifying the user that a specific amount of data has been transferred and ask if the user would like to order photos.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 1, 2, 4, 7-9, 11 and 12, because it fails to show or suggest each and every feature of the claims.

Claims 3, 5, 6, 13 and 14 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Clough and Ishijima as combined above, and further in view of U.S. Pub. No. 2004/0003151 to Bateman. The Office Action relies upon Bateman, adding it to the prior combination of references. This rejection is also traversed. Bateman neither discloses nor suggests a fourth communications device which receives image data and the predetermined user information from the home server apparatus, a third recording device which records the image data received by said fourth communications device for each user specified by the predetermined user information; a user data management device which manages image data of a user recorded by said third recording device, and a first output device which outputs the image data recorded by said third recording device to a medium when the user issues an order, wherein said user data management device updates at least one of a total number of pieces of image data and a total amount of image data about a user specified by the predetermined user information each time said fourth communications device receives image data and the predetermined user information from the home server apparatus, and automatically transmits message information to equipment registered in advance for the user when the updated result exceeds a predetermined value,

wherein the message information includes a proposal for the user to output image data to a medium, as recited in claim 1, and neither discloses nor suggests a third communications device which automatically transmits the image data recorded by said second recording device and predetermined user information to a predetermined print server apparatus, and an image data management device which manages image data recorded in said second recording device, and wherein said image data management device updates at least one of a total number of pieces of image data and a total amount of image data each time said third communications device transmits image data to the specified print server apparatus, and automatically transmits message information to equipment registered in advance when the updated result exceeds a predetermined value; wherein said message information includes a proposal to output image data to a medium from said print server apparatus, as recited in claim 7.

Bateman relates generally to data transfer between a peripheral device and an intelligent host. But Bateman in no way discloses or suggests the features noted as absent in the other references present in the combination as applied, as discussed above.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 3, 5, 6, 10, 13 and 14 because it fails to show or suggest each and every feature of the claims.

#### **Additional Cited References**

Since the remaining references cited by the Examiner have not been used to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

#### **Conclusion**

All objections and rejections raised in the Office Action having been properly traversed and addressed, it is respectfully submitted that the present application is in condition for allowance. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been

made to the outstanding Office Action, and as such, the present application is in condition for allowance. Notice of same is earnestly solicited.

Prompt and favorable consideration of this Amendment is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Paul T. Sewell, Registration No. 61,784, at (703) 205-8000, in the Washington, D.C. area.

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Respectfully submitted,

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